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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,243	08/28/2001	Geoffrey B. Rhoads	P0423	6983

23735 7590 06/28/2005

DIGIMARC CORPORATION
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EXAMINER	
VU, VIET DUY	

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/941,243	RHOADS, GEOFFREY B.	
	Examiner	Art Unit	
	Viet Vu	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *7-11,13-41,51,55-69 and 71-87* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *7-11,13-18,22-31 and 75-80* is/are allowed.

6)☒ Claim(s) *19-21 and 81-87* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *32-41,51,55-69 and 71-74* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Restriction:

1. New claims 32-41, 51, 55-69 and 71-74 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 7-11, 13-31 and 75-87, drawn to a method of encoding hyperlink information into a graphical image, classified in class 709, subclass 219, and class 380, subclasses 4 and 28.

II. Claims 32-41 and 55-68, drawn to method of controlling operation of host computer using data downloaded from a remote server, classified in class 709, subclasses 204 and 217.

III. Claim 51 drawn to method of encoding hyperlink information into an audio signal, classified in class 709, subclass 219 and class 380, subclasses 4 and 28.

IV. Claims 69 and 71-74, drawn to a specific object decoder for decoding embedded hyperlink information, classified in class 709, subclasses 219, and class 380, subclasses 4 and 28.

The inventions are distinct, each from the other because of the following reasons: Inventions I, II and III are related as

subcombinations usable together. Regarding inventions I and III, it is quite clear that the method of encoding audio signal is different than the method of encoding a graphic image. Invention II, on the other hand, has a separate utility such as control operation of host computer by using data downloaded from a remote server.

Inventions I and IV are related as combination and subcombinations. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP ∋ 806.05(c)). In the instant case, the combination I as claimed do not require the particular of the subcombination IV as claimed because conventional image encoder/decoder can be used in the invention I. The subcombination IV has separate utility such as data object for storing different types of data including image and audio data.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

2. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 32-41, 51, 55-69 and 71-74 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Objection to the Specification:

3. The amendment filed 5/4/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

New claims 81-87 recite a limitation that enables user to engage in a purchase transaction over the internet. This e-commerce functioning is not supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Non-Art Rejection:

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 81-87 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The original disclosure fails to provide reasonable written description of an interface that enables the user to engage in a purchase transaction over the Internet. It is submitted that a conventional interface for general Internet browsing does not automatically support conducting a purchase transaction over the Internet.

Art Rejection:

6. The text of 35 U.S.C. § 103(a) cited in the previous office action not cited here can be found in the previous office action.

7. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tow, U.S. pat. No. 5,315,098, hereafter '098, in view of Tow, European patent application No. 493,091, hereafter '091.

Per claim 19, the patent '098 discloses a system and method for embedding digital data onto a printed halftone image comprising:

a) receiving data corresponding to an initial graphic image, the data representing pixels, each having a value (see col 3, lines 25-47),

b) processing the initial graphical image to steganographically encode the halftone image with a received digital input data thereby hiding the digital data within the image (see col 4, line 48 - col 5, line 31),

c) producing/printing the image on physical medium for distributing to user who can decode the embedded digital data for use with an application, e.g., email (see col 1, lines 52-65).

It is noted that half-tone process can be used to process and print a continuous tone image.

The patent '098 does not explicitly teach embedding a network address. The patent application '091 teaches embedding onto a printed image many different types of digital binary codes including a hyperlink pointer, i.e. a network address (see col 4, lines 51-57).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the patent '098 to hide any conventional digital data in a printed halftone image including a network address. The use of a network address would have enabled the user to establish a communication link in the network, e.g., Internet.

It would have been further obvious to one of ordinary skill in the art to encode the digital data within any specific portion of the image including text or background (see '091 in col 5, lines 3-9 and '098 in col 4, lines 36-47).

Per claims 20-21, neither references teach accessing a remote data structure to obtain a network address. An official notice is taken that the use of a domain name server (DNS) to resolve network addresses in the Internet is well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a conventional DNS in Tow because it would have enabled resolving a network address.

Allowable Subject Matter:

6. Claims 7-11, 13-18, 22-31 and 75-80 are allowed over prior art of record.

Response to Amendment:

7. Applicant's arguments filed on 5/4/05 with respect to restriction requirement are not deemed persuasive.

Applicant alleges that the office action mailed 1/4/05 did not provide reasons for differentiating inventions I and II.

This is not found persuasive. The office action clearly pointed out a separately patentable utility of the invention II versus inventions I and III. This utility has a recognized independent status in the art.

Regarding claims 20-21, a typo error in the previous office action has inadvertently indicated that those claims were allowable over prior art. Claims 20-21 however should be rejected over the same ground of rejection as applied to claim 19 set forth above.

Applicant alleges that Tow does not teach a continuous tone arrangement because Tow is limited to a half-tone system.

This is not found persuasive. The alleged continuous tone process cannot be found in claims 20-21. The examiner submits that a half-tone system can be used to process and print an original continuous tone image.

Conclusion:

8. Applicant's amendment necessitated the new grounds of rejection, i.e., new claims 81-87. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is 571-272-3977. The examiner can normally be reached on Monday through Thursday from 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached on 571-272-3964.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit 2154
6/21/05

VIET D. VU
PRIMARY EXAMINER